APR 5 1937
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Supreme Court of the United States

October Term, 1936

No. 35

SAMUEL B. SMITH,
Petitioner,

v.

A. B. HALL and L. C. HALL, d. b. a.,
HALL BROTHERS,
Respondents.

SUPPLEMENTAL BRIEF FOR RESPONDENTS ON REARGUMENT

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SUPPLEMENTAL BRIEF FOR RESPONDENTS ON REARGUMENT.

Preliminary Statement.

It is not the purpose of this brief to cover any of the matters *fully* covered in respondents' main brief, but only to deal with some subjects which were discussed at the first oral argument and which are either not covered, or are insufficiently covered, in the main brief. We will also here briefly discuss the recent decisions of the Supreme Court of Canada which invalidated the Smith Canadian patent on the Hastings defense. Subsequent to the drafting of the

first two points of this brief, we saw a preliminary draft of a supplemental brief which is to be filed in the *James* case (No. 36). In order to avoid duplication, we will rest some parts of our case on that brief with explanatory statements to show the applicability thereof to our case. We might readily omit the first two points of our brief and rest the subject matter thereof on the *James* brief. However, we have determined to incorporate those points in this brief, both because we treat the question a little differently than is done in the *James* brief and because we will thus have a brief complete within itself containing the preliminary points upon which subsequent points are in part rested.

In our main brief reference was made only to Section 4886 R. S. (U. S. C. Title 35, Sec. 31) as the basis for the Hastings defense. Section 4920 R. S. (U. S. C. Title 35, Sec. 69) is equally applicable, but reference to it was inadvertently omitted. That section specifies the defenses which may be made in a patent suit, the applicable ones being as follows:

> "Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,
>
> "Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public."

ARGUMENT.

I.

This Court gave the patent in suit a broader interpretation than had been given to it previously by any Circuit Court of Appeals which passed upon the Hastings defense.

In addition to the present case, the *James* case, and those which were before this Court in *Smith* v. *Snow* and *Smith* v. *Waxham*, 294 U. S. 1 and 20, respectively, the patent in suit has been before two other Circuit Courts of Appeals, *i.e.*, the Sixth Circuit in *Wolf* v. *Buckeye Incubator Co.*, 296 Fed. 680, and *Buckeye Incubator Co.* v. *Petersime*, 19 F. (2d) 721, and the Third Circuit in *Buckeye Incubator Co.* v. *Cooley*, 17 F. (2d) 453, and *Buckeye Incubator Co.* v. *Hillpot*, 24 F. (2d) 341. We may eliminate from further consideration, for the purposes of the point now under discussion, the two Circuit Court of Appeals decisions which this Court had under review in *Smith* v. *Snow* and *Smith* v. *Waxham, supra*, because in neither of them was the Hastings defense presented. Nor was that defense advanced in the *Petersime* and *Hillpot* cases, but the decisions in those cases are important as showing the construction placed upon the patent by the Sixth and Third Circuit Courts of Appeals, respectively. We shall discuss first the construction given to the patent in suit, in so far as it affects the Hastings defense, by the Sixth and Third Circuit Courts of Appeals in the cases above mentioned, and then the construction given to it by this Court in the *Snow* case.

(1) *The Sixth Circuit Cases:* In the *Wolf* case, the Circuit Court of Appeals merely adopted the opinion of Judge

WESTENHAVER in the District Court. His opinion is reported in 291 Fed. 253. Referring to the published articles and rejected patent application which *alone* were relied upon in that case to substantiate the Hastings prior use defense, Judge WESTENHAVER said (p. 258):

> "Something is said about driving the air from top to bottom by a centrifugal fan, but the position and location of the fan with respect to the eggs and the *direction* of the drafts *are not defined*, much less is any provision disclosed for driving the air currents *in a defined channel* • • •. All that can be said is that heated air is to be forced into a chamber filled with eggs, *permitted to go where it pleases*, and escape by some undescribed method of ventilation." •

Referring to the abandoned patent application, he said (p. 259):

> "No *well-defined channels* for the circulation of the air are provided."

In the previous part of his opinion, Judge WESTENHAVER, referring to the Smith patent, said (p. 255):

> "The principle of operation and the hatching method for which this apparatus is designed consist in forcing mechanically a draft of heated air *downwardly through the central corridor*, where *it passes below the bottom of the partition or curtains and ascends through the column of egg trays* to the exit at the top of the respective egg chambers.
>
> • • • • • • •
>
> "A cycle of forced circulation of air through *definite channels*, it is said, is thereby obtained.
>
> • • • • • • •

• Where italics are used in quotations, it will be understood that the emphasis is ours unless otherwise stated.

> "In actual operation it is claimed that a continuous forced current of suitably heated air is driven *downwardly through the central corridor and upwardly through the two egg chambers.*"

The claims which were thus made for the patent he, apparently, accepted.

It is thus clear that he and the Circuit Court of Appeals considered that the Smith patent called for the circulation of the air "through definite channels" and in a predetermined and uniform course, *i.e.*, downwardly through the central corridor to the floor and then up through the column of egg trays or chambers. This method of circulating the air neither he, nor they, found in any of the publications relied upon by the defendant in that case or in the Hastings abandoned application.*

That we are correct in our interpretation of the construction of the Smith patent, by these Courts, is apparent, we think, from the opinion in the *Petersime* case. In that case, Judge MOORMAN said (p. 722):†

> "Looking to the language of the claims, as indeed to the device that Smith uses, it would seem that he had in mind a process by which the warm air taken into the corridor would be *currently directed, so as to strike first the eggs in the more advanced incubation* * * *."

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*There was no evidence in that case of the Hastings defense other than the publications and the abandoned application. Apparently not even the file wrapper of the application was before the Court.

†Judge DENISON sat both in the *Petersime* and *Wolf* cases.

Again, on the same page, referring to the Smith patent and the alleged infringing device, he said:

> "This conception of a current of air driven in a *definite* or *predetermined* direction is different, we think, from the Petersime process, by which diffusion of heat units and uniformity of temperature is obtained by the slow stirring or *agitation* of the air in the egg chamber."

Moreover, Judge WESTENHAVER's later decision in *Buckeye Incubator Co.* v. *Blum*, 17 F. (2d) 456 (where the Hastings defense was not involved) indicates what he meant in the *Wolf* case by his statement that the publications relied upon to establish the Hastings defense did not show that the currents of air were driven in "well defined channels". He held in the *Blum* case that the Smith patent was *not infringed* by a device where the air was *"agitated"* but not driven "in any uniform or ascertainable direction". Referring to the equalization of temperature in the device then before him and the effect of the air not moving in the manner just stated, he said (p. 459):

> "If adequate uniformity of temperature is obtained, it is accomplished only in this manner. In this sense and manner only can it be said that heat units are carried *from eggs in the advanced to eggs in a less advanced stage of incubation.* If claim 1 calls for a current of air forcibly created and driven against the eggs in any *definite* or *ascertainable* manner or *direction,* then defendant's device does not appropriate that step. It is not capable of creating or *directing* such a *current* or functioning in accordance with that principle."

His opinion shows clearly that he considered that there should be some means "for restricting more or less the channels through which it (the air) is driven" (p. 460). In

both this latter case and the *Petersime* case there was an open chamber *without partitions* (other than trays) which would *guide* the current of air.

(2) *The Third Circuit Cases:* The opinion of the Circuit Court of Appeals for the Third Circuit in the *Cooley* case makes it very clear that the Court considered that the Smith patent called for "establishing" a current of air "*regulated* in its *direction*" and so "*controlled*" that it passes first through the eggs at the bottom of the incubator upwardly or, as expressed in the opinion "first, through the old heat radiating eggs, and next, as it ascends, to the new heat absorbing eggs • • •". Referring to the *Hastings* device, Judge WOOLLEY said (p. 454):

> "Heated air is driven from the top downwardly against and around the eggs where, after circulating about them, it escapes through the chamber doors or other openings. • • • More important still, there was no arrangement for establishing and *regulating* currents of heated air and, similarly, no provision for obtaining uniformity of temperature other than that initially provided by the heating means. Moreover it should be noted that the heated air, like the wind, *would go where it listeth* and, accordingly, it *acted as it pleased.*"

Again, on page 455, he said:

> "Hastings and Smith, the patentee, no doubt saw the same incubating problems, but Smith pursued a solution *directly opposite* to that of Hastings."

The opinion then goes on to point out that Smith *regulated* and *controlled* the *direction* of his current of air first, *through the central corridor* to the bottom of the incubator, where it ascended through the heat radiating eggs to the heat absorbing eggs. The construction given to the Smith

patent in the *Cooley* case was commented upon by the Circuit Court of Appeals for the Second Circuit in the case at bar, where it was said that the Third Circuit found that the Hastings prior uses "were not of Smith's method because they did not *provide for a regular current of air*".

In the *Hillpot* case, it was held both by the District Court (22 F. (2d) 855) and by the Circuit Court of Appeals that the defendant did not infringe. In the District Court, Judge Bodine construed the opinion of the Circuit Court of Appeals in the *Cooley* case to hold (p. 857), as we have above construed it, that the patent disclosed and was limited to "air currents passing first through the eggs in advanced stages of incubation to those in less advanced stages of incubation". He found that this method was not practiced by the defendant, whose air currents went *upwardly* from the fans and *down* through the trays. The Circuit Court of Appeals, after pointing out that the infringement in the *Cooley* case was so clear that there was no occasion to construe the claims, stated that in that case and in the *Wolf* case it had been held that Smith had conceived a new method "whereby heated air, instead of being driven *hither and yon* throughout the closed chamber, is driven in currents and made to circulate in the form of columns of air in *predetermined* paths • • • " (p. 342). The Court did not, in that case, construe the Smith patent as being limited to directing the current of air first, to the eggs in the more advanced stages of incubation and then to those in the less advanced stages, but adhered to the view that the "essence of the invention • • • is *forced* circulation of heated air in *predetermined* direction • • • " (p. 344), brought about by a *corridor* between the tray tiers *partitioned from the latter by curtains* or, of course, the equivalent thereof. It was held that Hillpot did not infringe because he *omitted the curtains* or their equivalent covering the ends of the trays

adjacent to the openings or corridors between the trays tiers and the walls of the incubator, and corresponding to the central corridor of the apparatus shown and described in the Smith patent. The effect of this omission was stated to be (p. 345):

> "Instead of one strong current moving in *one direction* in *trunk* form, Hillpot has a trunk current only on leaving the fan; then it divides into a multitude of branches which follow *no defined courses* but only courses made by the least resistance."

The Hastings prior use was not asserted as a defense in the *Hillpot* case.

(3) *The Decisions of This Court*

(a) In the *Snow* case it was pointed out by this Court (p. 8) that infringement was sought to be avoided upon the ground that "claim 1 is restricted to an arrangement of the eggs in such order with respect to the *direction* of the propelled current of heated air that *it will first* come in contact with the more *advanced* eggs"; and "that the movement of air" in the accused device did "not result in 'a current of air' traveling in a *constant predestined* path • • •". This Court, while conceding that the specifications show an arrangement whereby the air would be first directed to the eggs in the more advanced stages, held that the patent was not so limited.

(b) After referring to the arrangement of eggs and the means of guiding the current of air shown in the specifications, it was said (p. 11):

> "But neither the arrangement nor the means of *guiding* the current of air are requisite to the application of the principle which Smith discovered and claimed.
>
> • • • • • • •

> "Claim 1 made no mention of curtains or any column of air or means of guiding the current of air, and the inventor made no claim for any particular arrangement of the eggs, except that they should be at different levels. Moreover, while the specifications and drawings show a particular arrangement of the eggs and a *particular direction* of the current, nowhere, in specifications or claim, is it stated either that the *direction* of the current is material or, what is the equivalent, that the order in which it reaches the eggs is material."

The same conclusion is stated on pages 13-14.

(c) In reference to the file wrapper and the changes which had been made in the various sets of claims presented to the Patent Office, this Court said (p. 15):

> "• • • none of these additions involve any particular order of arrangement of the eggs or any particular *direction or control* of the air current • • •,"

except that it is to be of sufficient velocity to circulate, maintain, and diffuse the air throughout the chamber at substantially the same temperature. See also page 16.

(d) In discussing the question of infringement, the Court said (p. 19):

> "Claim 1, as already stated, does not call for a current of air moving in any *particular direction.*"

(e) Referring to the infringing device and inferentially to what the patent requires in the way of air currents, this Court said (p. 19):

> "That there is a *mixture* of the air and *some confusion of its movement in the corridor,* and that at different levels within the space occupied by the tiers of trays the *movement is not in the same direction,*

> *is immaterial.* It is enough that there is a movement of air in current form following substantially defined paths *through the tiers of egg trays, sufficient to effect the desired transfer of heat units.* Claim 1 does not prescribe that a *current* of air is to be maintained *throughout* the chamber."

The Court then went on to hold that the respondents accomplished this result "by the currents of air set in motion either directly or indirectly by the movement of the blades of the propellers".

(f) In the *Waxham* case (p. 22) it was held that there was infringement, although there was no central corridor, the tiers of egg trays being placed in or near the center of the chamber, and there were no curtains or other means of guiding the air currents set in motion by the fans.

(g) As to what the specifications and claims contemplate, the Court said (p. 12):

> "The specifications and claim both contemplate a continuous circulation of the current of heated air through the chamber, which, *regardless of its direction,* would continuously operate, by repeated contacts with the eggs in all stages, to equalize the temperature throughout the chamber by carrying heat units from the warmer to the cooler eggs."

(4) *Summary:* It is apparent, we think, from the foregoing extracts from the opinions of this Court in the *Snow* and *Waxham* cases that a much broader and more liberal interpretation was given to the Smith patent by this Court than by the Circuit Court of Appeals for the Sixth and Third Circuits.

It is clear that the Circuit Courts of Appeals which considered the Hastings defense before this Court's de-

cisions in the *Snow* and *Waxham* cases rejected it* because they construed the patent to call for *regulated* or *controlled* currents of air moving in a *predetermined* and *well-defined* channel. In the *Wolf* case, no *specific* direction or path was specified. But the same Court later, in the *Petersime* case, held that the current was *first to go to the eggs in the more advanced stages of incubation.* This latter view clearly seems to have been that of the Circuit Court of Appeals for the Third Circuit in the *Cooley* case. But in the later *Hillpot* case, that Court did not so definitely limit the patent, but nevertheless adhered to the view that the current must be directed "in *predetermined* paths", and held that infringement was avoided by the *omission of curtains,* or their equivalent, covering the ends of the trays adjacent to the openings or corridors between the trays and the walls of the incubator, such openings corresponding to the central corridor of the Smith patent.

This Court, on the other hand, held not only that it was unnecessary, under the Smith patent, that the air should first reach the eggs in the more advanced stages of incubation, but the patent did not even require a central corridor or its equivalent, with curtains or similar means for guiding the air currents or, indeed, that there shall be any particular order or arrangement of the eggs or that the air should travel in a constant *predetermined* path or that it should be specifically *directed* or *controlled.* On the contrary, it was sufficient if there was a continuous circulation of a current of heated air which, *regardless of its direction,* would continuously operate, by repeated contacts with the eggs in all stages, to equalize the temperature throughout the chamber by carrying heat units from the warmer to the cooler eggs.

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* As will be presently shown, the defense was also rejected by the Sixth Circuit because it was not established.

II.

The Hastings defense was rejected by the Circuit Court of Appeals for the Third Circuit wholly, and by the Circuit Court of Appeals for the Sixth Circuit partly, because of the comparatively narrow interpretation which those courts gave to the patent in suit.

In the *Wolf* case, the Hastings defense was rested *entirely* upon "four newspaper articles and his rejected application for a patent". Hastings was not called, nor did any witness testify as to what he had done. It was said that none of the articles gave "any definite or specific description whereby one skilled in the art could reproduce the Hastings structure", and that it was not proven, nor could it be discovered from the articles, whether the hatcheries referred to in the articles were "a commercial and practical success" (pp. 257-258). There is nothing in Judge WESTENHAVER's opinion which would indicate that more of Hastings' file wrapper than the abandoned application was before him.*

But it is also perfectly clear, we think, from his opinion, that he and the Circuit Court of Appeals relied not only upon the *insufficiency* of proof of the Hastings prior use, but upon the further fact that neither the publications nor the abandoned application exhibited "*well-defined channels* for the circulation of the air", a feature considered by them to be an essential part of the Smith patent, and in the

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* The Circuit Court of Appeals for the Second Circuit, and respondents in their main brief, rely also upon the statements in the *subsequent* proceedings in the patent office. The application was prepared by Hastings himself when a young man about 27 years of age.

Petersime case interpreted to mean that the current be so directed "as to strike first the eggs in the more advanced incubation".

In the *Cooley* case, the *sufficiency* of the proofs to establish a prior use by Hastings, as distinguished from the details of the use, was not questioned by the Circuit Court of Appeals, but the defense was rejected on the *sole* ground that Hastings had no means for *regulating* and *directing* the currents of air in the manner taught by the Smith patent. The District Judge said that in "the present day description of this hatchery and the drawings now made, a complete anticipation is indicated" (p. 2 of Appendix to Petr's. Brief). These remarks related to the incubator at the Davis farm. Judge BODINE did not discuss the Muskogee incubator other than to state that it was "a complete financial failure". As shown in the brief for respondents in the *James* case (pp. 7-10; 29-54), any deficiency of details as to the Muskogee incubator which existed in the *Cooley* case was supplied quite overwhelmingly in the *James* case. As previously stated, the Circuit Court of Appeals in that case pointed out that while Hastings and Smith doubtless saw the same incubating problems, "Smith pursued a solution *directly opposite* to that of Hastings" (p. 445); the former regulating and controlling the direction of the current of air and the latter failing to do so, the air in his apparatus going "where it listeth" and acting "as it pleased". As previously pointed out, in that case the Court held that Smith attained "uniformity of temperature" by directing current "first, through the old heat radiating eggs, and next, as it ascends, to the newer heat absorbing eggs".

III.

The decision of the Court below invalidating the patent in suit on the Hastings defense was unavoidable in the light of this Court's interpretation of the patent.

It is not our purpose to discuss this point in any detail in this brief. The evidence to support the Hastings defense is referred to at length in our main brief (pp. 7-21) and in the original brief of respondents in the *James* case (Point I, pp. 12, *et seq.*). The opinion of the Circuit Court of Appeals likewise summarizes the evidence, particularly the documentary part thereof, quite fully.*

In our original brief the evidence relating to the Hastings defense was considered with reference to claim 1 of the patent (the only claim in suit). It is our purpose here to briefly discuss the evidence with reference to this Court's interpretation of that claim.

If we are correct in our understanding of this Court's opinions in the *Snow* and *Waxham* cases that the Smith patent does not require that there shall be any particular order or arrangement of the eggs or that the propelled current of air should reach the eggs in any particular order, or that it should be guided, controlled or directed by any particular means or in any particular manner, but merely that there shall be a continuous circulation of the heated air through the chamber, which, *regardless of its direction,* would continuously operate, and at sufficient velocity, by repeated contacts with the eggs in all stages, to equalize the temperature throughout the chamber, then, we submit that it inevitably follows that the Hastings defense invalidates the patent.

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* R. pp. 238, *et seq.*

Hastings' first publication in "The Dollar Hen"* shows that as early as 1909 he conceived, and in the article taught, *staged incubation*, and "the use of a steady current of air" forced into the incubator by a motor driven fan or blower, "the rate of movement of which (air) may be *varied at will*" but "always"—sufficiently *brisk*, however, "to prevent an unevenness of temperature in different parts of the room". Here is a complete exposition of the invention covered by claim 1 of the Smith patent as construed by this Court. "The Dollar Hen" standing alone as a publication, we submit, should invalidate the Smith patent under Section 4886 R. S. (U. S. C. Title 35, Sec. 31.)

Moreover, it shows that Hastings was the prior inventor within the meaning of Sec. 4920 R. S. because the article shows the conception and the communication of the invention to others prior to Smith, and the Davis and Muskogee incubators show that the same was reduced to practice before Smith. See *Milburn Co.* v. *Davis-Bournonville Co.*, 270 U. S. 390.

Hastings' patent application, coupled with the arguments and briefs submitted in connection therewith,† show conclusively that in 1911-1912 he had conceived, and reduced to practice, constructively at least, every element which this Court has found constitutes claim 1 of the Smith patent.‡ As will be presently shown, his reduction to practice

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* Quoted on page 15 of original brief for respondents in the *James* case.

† Deft.'s Exh. F, p. 246, Hall Record.

‡ An excellent comparison of the elements of the Smith claims and the corresponding features of the Hastings prior use will be found in the opinion of the Supreme Court of Canada which invalidated the Smith patent. As will be presently pointed out, a copy of this opinion appears under separate cover, which will be submitted as an appendix to this brief.

was also actual in those years. Even in the original application, which as before stated, was drawn by Hastings, he states that he secured "a more *uniform temperature* throughout the hatching chamber by substituting a *forced draft* for gravity drafts", and ventilation "through cracks around the door of the heating chamber or other small openings in any part of the air circuit".* The arguments addressed to the Patent Office are replete with references to staged incubation; forced and "rapid" circulation of heated air; the maintenance of *uniform* heat, the *even distribution* of heat, continuous circulation of a current of air; the introduction and regulation of moisture; the carrying of air from the warmer to the cooler eggs, and the equalization of temperature throughout the chamber.†

There is no more reason for supposing that the fan or blower in the Hastings device would not produce currents of air "without substantial variations of path" than this Court said in the *Snow* case would be the expected result of "a fan operating • • • within a closed chamber under substantially constant conditions". This Court said in the *Snow* case that the condition just referred to would be expected to follow "if it be assumed, without deciding", that the Smith patent called for "a current of air so constant in its movement and direction as not to depart substantially from a well-defined path" (pp. 19-20). The currents of air in the Hastings device were set in motion "by the movement of the blades of the propellers", which this Court in the *Snow* case said was done by the device held to infringe in that case and that such a "method is that of Smith" (p. 20).

The testimony of Mr. Hastings, which Judge HINCKS, (who saw and heard him on the witness stand) in the Dis-

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* R. 250-251.

† R. pp. 261-277.

trict Court referred to as "candid",* and the testimony of Mr. and Mrs. Davis, show quite conclusively that Hastings practiced successfully for commercial purposes, at the Davis poultry farm in Brooklyn from March until May, 1911, the Hastings method of incubation described in the abandoned application and the file wrapper thereof, and that thereafter Davis alone practiced it until 1913 when, owing to financial reverses, he was compelled to abandon his farm. The Hastings incubator, which had been built in the cellar, was too large to be removed without taking it apart and it was accordingly dismantled.† We will not discuss in detail the testimony of these witnesses in this brief because it is quite short, all of it being found from pages 50 to 64 of the record. It is also discussed in our main brief and in the James brief on reargument. Their testimony is fully corroborated by the letter written on May 20, 1911, a copy of which was incorporated in a publication which Hastings put out after he left the Davis farm and which is referred to in petitioner's cross examination of Hastings at page 55 of the record. This letter is quoted in full on pages 23-24 of our main brief, and is part of Plaintiff's Exhibit 1 in the *James* case.

It was urged at the previous argument and in petitioner's brief that Hastings did not force his air into his incubator with sufficient speed. This point is fully answered in Point VI of "Respondents' Brief on Reargument" in the *James* case. What is there said is applicable to the present case. Moreover, Hastings' patent application and file wrapper show that he contemplated the use of "a *rapid* circulation of air through the whole collection of eggs in the chamber and past the heater" and that "the con-

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* R. p. 218.

†R. p. 61.

ditions" should be "maintained uniform".* In his earlier "The Dollar Hen" article he pointed out that the air must be sufficiently *brisk* "to prevent an unevenness of temperature in different parts" of the incubator and that it might be "varied at will".

There is no conceivable reason why, when Hastings came to build and operate incubators, he should have departed, so far as the velocity of the air is concerned, from what he clearly showed in his representations to the Patent Office and the last mentioned publication was his conception, namely, that the air currents in the incubator should be sufficiently brisk or rapid to accomplish what this Court said was an essential of the Smith invention "to equalize the temperature throughout the chamber". In addition, the evidence indubitably establishes that eggs were hatched in staged incubation and in large numbers, both numerically and on a percentage basis, at both the Davis farm and at Muskogee. This could not have happened had the air not been driven at sufficient velocity to equalize the temperature.

In the brief filed on behalf of Hastings before the Board of Examiners-in-Chief in the Patent Office, there is quoted a statement by Hastings in which appears the following: †

> "In the practical plant the *entire* volume of air passes *through the fan* every thirty seconds."

This, of course, is a very rapid movement. It is not inconsistent with what is said immediately following in the same statement that the air is blown "past each and every egg at the rate of 30 feet per minute". In Petitioner's Exhibit 11-A in the *James* case (reproduced opposite p. 25 of the *James* brief on reargument) the air is shown as leaving the

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* R. p. 273.
† R. p. 275.

fan at the rate of from 400 to 500 feet per minute, yet is passing the eggs in many places at the rate of only 40 feet per minute.

Hastings did not abandon his idea when he left the Davis poultry farm, but went on to Muskogee, Oklahoma, where he built and operated successfully a considerably larger incubator. Indeed, when Hastings left the Davis farm he prepared a booklet which he published with the idea, as he expressed it, that he "was going to capitalize on this idea of mine".* This booklet (introduced as Exs. D-C in the Cooley record) is part of Plaintiff's Exhibit 1 in the *James* case. (See James record at pp. 581 and 1294.) Hastings was employed by Davis simply to build an incubator and to operate it, apparently, for a time. He was paid by Davis for building the machine and for operating it. It was understood at the time that Hastings was thus engaged that Davis was to have the right to operate the device and thus to use the Hastings method.† As pointed out in the original brief in the *James* case (p. 41) the Muskogee incubator was not financially successful because an attempt was made to do custom hatching for those who supplied eggs to the hatchery at what turned out to be the commercially impossible price of 1¢ an egg. But the operation of the incubator itself was successful.

It is difficult to see how, in view of the decision of this Court in *Corona Cord Tire Co.* v. *Dovan Chemical Corp.*, 276 U. S. 358, the Circuit Court of Appeals could have reached any different conclusion than it did. The uses of the Hastings incubator at the Davis poultry farm in Brooklyn and at Muskogee, Oklahoma, were certainly successful, *beyond* the extent required in the *Corona* case.

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* R. p. 55.

† R. pp. 52, 57 and 59.

As will be shown under the next point, the Supreme Court of Canada has recently expressed the view which we have advanced under this point.

IV.

The Supreme Court of Canada has recently invalidated the Smith Canadian patent, which is exactly the same as the patent in suit here, on the Hastings prior use and invention.

When this case was originally before this Court, petitioner filed an appendix to its original brief, consisting, among others, of a copy of an opinion of the Exchequer Court of Canada in a suit which had been instituted by the Attorney General of Canada to impeach the Smith Canadian patent No. 217,777 issued in 1922 (*The King* v. *The Smith Incubator Company, et al.*). *This patent is exactly the same as the patent in suit here.* The principal basis of the attack was the Hastings publications, prior use and inventorship. Without referring to the interpretation given by this Court to the Smith patent, the Court rejected the Hastings defense, and apparently adopted as his reasons therefor those advanced by the Third Circuit Court of Appeals in the *Cooley* case. He added, however, that he had come to his conclusion "not unhesitatingly". On the same date that the opinion in the case just referred to was handed down, the same judge in an infringement suit brought by the Smith Incubator Company against one Seiling declined to follow this Court's interpretation of the Smith patent and gave to it the narrow construction which the Circuit Court of Appeals for the Third Circuit had given to it in the *Cooley* case. After stating how he felt that the claim must be construed, Judge Angers said:

> "With all due respect I must say that I am unable to accept the view expressed by the Supreme Court of the United States in the case of Smith v. Snow (1). The extremely *broad interpretation* given to claim 1 of the Smith patent in the said case is not in accord with the principle laid down in re Western Electric Company Inc. c. Baldwin International Radio of Canada (ubi supra) and the decisions therein cited".

There was an appeal in both cases to the Supreme Court of Canada, and in each the patent was held invalid on the Hastings prior use and invention.

In the case *attacking the validity* (*The King* v. *Smith Incubator Company*) of the patent, the Supreme Court agreed with the construction of the patent given to it by *this Court* and then went on to say that that conclusion

> " . . . is, in our view, decisive in respect to the main ground upon which the learned trial judge based the validity of the respondents' patent; for what was said of Claim 1 by the United States Supreme Court is also true of the other claims; and it follows that, having regard to Milo Hastings' operations and prior public use in Muskogee, as established in the present case, Smith's claims in the patent in suit are obviously too wide.
>
> . . . . . .
>
> "Indeed, and more particularly in view of the opinion delivered by Mr. Justice Stone on behalf of the Court, we are led to believe that had the prior public use of the patented method and knowledge thereof by Milo Hastings been adduced in evidence in the Snow case, the result would have been different".

The Court then commented upon the decision of the Circuit Court of Appeals for the Second Circuit in the case at bar, approved of the same, and said:

> "What was said of the situation in the United States in the latter judgment equally applies to Canada as the law stood at the time when the disputed patent was issued".

In the *Seiling* case, the Supreme Court followed the conclusion which it had reached in *The King* v. *Smith Incubator Company, et al.*, regarding the validity of the Smith patent. For the convenience of the Court we have printed under separate cover, as an appendix to this brief, a copy of the opinions of Mr. Justice RIDDELL in the cases just referred to. We will have a certified copy of the Canadian patent at the argument, which will be left with the Court if the Court wishes it. Claim 1 of the Canadian patent is quoted in the opinion in the suit to invalidate the patent. Comparison will show that it is word-for-word the same as claim 1 of the patent in suit.

V.

Petitioner's position in reference to the Hastings defense precludes a finding that the respondents' practice since 1930 or 1931 * infringes the Smith patent.

In support of this proposition, we will rely in addition to our main brief, upon Points IV, V, VI and VII of "Re-

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* There is some confusion in the printed record as to whether respondents adopted the separate hatching method *exclusively*, in the fall of 1930 or 1931. In the printed record, at page 64, Mr. Hall is reported to have testified that this took place in the fall of 1930. Yet, in another part of the record, the same witness states that respondents adopted separate hatching exclusively, about September, 1931, and started using it as part of their practice in January, 1931.

spondents' Brief on Reargument'' in the *James* case. What is there said is equally applicable to the *Hall* case.

The great advantages of separate hatching are pointed out at pages 64 and 71 of the *Hall* record. These advantages are developed more fully in the *James* record.

Conclusion.

It is respectfully submitted that the decree of the Court below should be affirmed.

Respectfully submitted,

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